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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,788	01/10/2001	Michael C. Scroggie	CAT/29US-SCRCO3	6599
31518	7590	05/04/2004	EXAMINER	
NEIFELD IP LAW, PC 2001 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202			GRAVINI, STEPHEN MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 05/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,788

Applicant(s)

SCROGGIE ET AL.

Examiner

Stephen M Gravini

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 32-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 32-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3622

DETAILED ACTION

Claim Rejections - 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 32-56 and 58-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Jovicic et al. (US 5,855,007). Jovicic is considered to disclose a system or method comprising:

a web site for providing purchasing incentives from multiple sources (column 6 lines 4-48 wherein the disclosed internet coupon notification center is considered to be patentably equivalent to the claimed multiple source web site purchase incentive);

a consumer purchase history database based on consumer online shopping activity (column 6 line 61 through column 7 line 61 wherein the disclosed electronic coupon redemption center accounting purpose is considered to implicitly anticipate the

Art Unit: 3622

claimed online purchase history database because redemption implies purchase history and accounting implies database shopping activity, column 7 line 66-67 expressly teaches the claimed online shopping purchase history because the disclosed shopping patterns of a particular user is considered to be based on shopping purchase history, and column 9 lines 19-28 wherein the disclosed past transaction recordation of coupon server database access implies an online consumer purchase history database because coupons associated with online shopping indicate history as claimed);

a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site (column 6 line 58 wherein the disclosed customer internet address is considered to anticipate the claimed consumer e-mail address because based on applicants' specification, it would be reasonable to broadly construe the terms as patentably synonymous and column 7 line 36 wherein the disclosed customer internet address or claimed consumer e-mail address is considered to be stored in a database);

receiving a consumer's e-mail address from a consumer's computer (column 8 lines 18-22 wherein the disclosed user self e-mailing is considered to expressly teach to consumer e-mail receipt);

maintaining a consumer email database which can identify consumers by their e-mail address (column 6 line 58 wherein the disclosed customer internet address is considered to anticipate the claimed consumer e-mail address because based on

Art Unit: 3622

applicants' specification, it would be reasonable to broadly construe the terms as patentably synonymous);

formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon (column 7 lines 45-55 wherein the disclosed internet coupon server electronic mail print out is considered to expressly anticipate the claimed e-mail formatting for coupon printing); and/or

means for delivering purchasing incentives or notices to purchase a specific manufacturer product to consumers by e-mail or means for delivering e-mail notices which remind consumers to visit the web site or transmitting purchase incentives via an e-mail post office or transmitting to consumers a notice to visit the web site via the consumer email address or generating targeted purchase incentives from a consumer purchase history database (column 7 lines 40-45 wherein the disclosed electronic mail message communication is considered to expressly disclose the claimed delivery means, reminder means, transmitting method, or generating method). Jovicic is also considered to disclose the claimed consumer profile (column 6 line 59), purchase history and consumer database integration (column 8 line 7), independently administered web site (column 10 line 34), cooperative site (column 10 line 36), past purchasing activity (column 7 line 66), shopping list selection data (column 8 line 50), rebate offer data (column 2 line 37), manufacturer or retailer web site links (column 7 line 58), product or sample information request (column 7 line 65), consumer favorite brands (column 6 line 59), customer identification number or name storage (column 7 line 27), demographic information (column 1 line 63), targeted time phased incentives

Art Unit: 3622

based on consumer actual buying patterns and preferences (column 8 line 19), generating untargeted incentives (column 1 line 61), printed data enabling coupons (column 7 line 47), point of sale printing (column 2 line 64), token encoding identification card (column 7 line 27), shopping list selections (column 6 line 50), and particular consumer specific offers (column 6 line 60).

Claim 57 is rejected under 35 U.S.C. 102(e) as being anticipated by Golden et al. (US 5,761,648). Golden is considered to disclose a system or method comprising:

- a personal database 2;

- a purchase history database wherein the data on consumer purchases are based on consumer online shopping activity (column 4 lines 27-39 wherein the disclosed issuer coupon file data base with card check-out activation online is considered to expressly teach the claimed online consumer shopping activity history database);

- means for generating a web page with a consumer-specific display (column 4 line 60 wherein the disclosed downloaded display by login password entry is considered to imply the claimed consumer specific web page display because a downloaded login would generate a specific consumer display);

- means for updating said web page (column 5 line 7 wherein the disclosed coupon update instructions is considered to expressly teach the claimed web page update means); and

Art Unit: 3622

means for informing the consumer by e-mail of new incentives (column 1 line 30-40 wherein the disclosed mail packs or mail lists when read in conjunction with the disclosed online electronic certificate is considered to imply the claimed informing means because new incentives to consumers inform via electronic means and mail means).

Response to Amendments & Arguments

Applicant's arguments filed March 15, 2004 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 32-91 have been considered but are moot in view of the new ground of rejection.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 3622

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is Asteve.gravini@uspto.gov. Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.**

Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
April 30, 2004